

## RESPONSE AND REMARKS

Claims 1-63 were previously cancelled and Claims 64-79 were previously added to more distinctly claim the invention. Reconsideration of the application in view of the Response and Remarks below are respectfully requested.

### **REJECTIONS UNDER SECTION 103(a)**

In the Office Action, Claims 64-67 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kara et al. (U.S. Patent No. 6,233,568; "Kara") in view of InterShipper; (Newsbytes Article, Internet Update; "InterShipper"). Office Action, Topic No. 3, p. 2.

The Office Action rejected Claims 68-79 under 35 U.S.C. §103(a) as being unpatentable over Kara and InterShipper, and further in view of UPS® Service Guide ([www.ups.com](http://www.ups.com); "UPS") and FedEx® Services ([www.fedex.com](http://www.fedex.com); "FedEx") and Barnett et al. (U.S. Patent No. 6,369,840; "Barnett"). Office Action, Topic No. 7, p. 3.

In rejecting the Claims, the Office Action concedes that "Kara ... fails to disclose the simultaneous display of the rates for each carrier that includes rates of different services...." Office Action, Topic No. 5, p. 3; Office Action, Topic No. 9, p. 4.

In view of the above-conceded failure by Kara, the Office Action asserts that "InterShipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3)." Office Action, Topic No. 5, p. 3; Office Action, Topic No. 9, p. 4.

With respect to the rejection of Claims 68-79, the Office Action further concedes that "... Kara does not specifically disclose the rates being calculated with respect to day and time." Office Action, Topic No. 10, p. 4. In view of the above-conceded failure of Kara, the Office Action asserts though, that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. It would have been obvious ... to include the time sensitive 'urgency' services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time

advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance.” Office Action, Topic No. 10, p. 5 (citing FedEx, page 1).

The Office Action then concedes that “Kara, Theil, UPS® and FedEx® fail to disclose the use of a simultaneous display with [sic] shows the date and time of services ...” Office Action, Topic No. 10, pg. 5. In order to compensate for the conceded failure of the other cited references, the Office Action then asserts that “Barnet [sic] discloses the use of a calendar which can be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9).” Office Action, Topic No. 10, pg. 5. The Office Action then concludes that “[i]t would have been obvious ... to have the display of rates of Kara, InterShipper, UPS® and FedEx® with respect to day and time, include the day and time, [sic] as disclosed by Barnett, in order to provide a single integrated display that allows a user to order or purchase a system based on the calendar day and time.” Office Action, Topic No. 10, p. 5 (citing Barnett, column 2).

#### **REMARKS REGARDING SECTION 103(a) REJECTIONS**

The rejections under Section 103(a) have been carefully considered. Claims 64, 68, 69, 72-74, 76 and 79 have been amended to more distinctly claim the claimed invention.

For the below-given reasons and the below-cited authorities, it is respectfully asserted that the conclusions by the Office Action of obviousness are not properly supported by sufficient evidence as required for an obviousness rejection under MPEP §706.02(j) and MPEP §2143.

Moreover, for the below-given reasons and the below-cited authorities, it is respectfully asserted that none of the cited references, whether considered alone or in combination with any other reference of record, disclose, anticipate, teach or suggest all of the limitations of Claims 64-79 and that the combination of limitations claimed by Claims 64-79 are therefore non-obvious in view of the references of record. It is therefore respectfully requested that Claims 64-79 be reconsidered and allowed.

In particular, for the reasons given, and the authorities cited, below, it is respectfully asserted that the combination of references asserted by the Office Action as

a basis for its conclusions of obviousness fail to disclose a simultaneous display of rates for each of multiple delivery services offered by each of multiple carriers.

Further, for the below-given reasons and the below-cited authorities, it is respectfully asserted that the combination of references asserted by the Office Action as a basis for its conclusions of obviousness fail to disclose a simultaneous display of days (or days and times) identified for delivery of a particular parcel by each of multiple delivery services offered by each of multiple carriers according to a particular shipping date.

Yet further, the below-given reasons and the below-cited authorities, it is respectfully asserted that the complete absence of the combination of limitations recited by the Claims of the present application from the combination of references asserted by the Office Action, is strong evidence that the combination of limitations recited by the Claims of the present application are therefore not obvious.

**A. Simultaneously Displaying Shipping Rates for each of Multiple Delivery Services Offered by each of Multiple Carriers is Non-Obviousness**

It is respectfully asserted that the combination of limitations of, for example, amended independent Claim 64, for "... simultaneously displaying said first, second, third, and fourth shipping rates to said user ..." is not disclosed, anticipated, taught or suggested by any combination of the references of record.

It is respectfully acknowledged that the InterShipper reference makes the following statements:

Internet users can now get shipping rates from all major shippers in just a few seconds. Simply enter your origin, anywhere in the U.S. is OK, and destination, worldwide, along with your package weight and dimensions. The free service will return every method possible that you can use to ship your package and arrange the results in cost order, and color code the results by approximate transit time.  
World Wide Web: <http://www.wwmerchant.com/iship>.

InterShipper, p. 1, ¶2.

The Office Action is apparently asserting that the above-quoted statements should be inferred to indicate that the InterShipper reference simultaneously displayed

its results, and that the InterShipper reference included multiple delivery services offered by multiple carriers in its results.

It is respectfully asserted that both such inferences are equally misplaced and unsupported.

Importantly, the cited InterShipper reference is a publication, not a U.S. patent. As such, there is no presumption of enablement as to the disclosure of the cited InterShipper reference. Moreover, as to the Claims of the present application, it is respectfully asserted that the cited InterShipper reference is not enabling.

Although the cited InterShipper reference may qualify as a prior art reference under Section 103, it may only be used as a prior art reference "... for what is in fact disclosed in it." Reading and Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 652 (Fed. Cir. 1984) (finding a non-enabling promotional brochure cannot be used as a vehicle for qualifying a later filed patent as prior art).

In particular, it is respectfully asserted that, contrary to the inferences apparently asserted by the Office Action, the InterShipper reference never states that the InterShipper service would display its results simultaneously. Rather, the InterShipper reference states only that "[t]he free service will return every method possible that you can use to ship your package ...." It does not say that such returned "every method possible" will be simultaneously displayed.

It is therefore respectfully asserted that the inference apparently asserted by the Office Action that the InterShipper reference discloses a simultaneous display where, in fact, none is disclosed, is evidence that the rejection improperly imports a perspective gleaned from the present application to impermissibly read a non-existing feature into the InterShipper reference and the combination of that reference with the other cited references. Cf. In re Mahurkar Patent Litigation, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

Moreover, it is respectfully asserted therefore, that the invention claimed as a whole by, for example, Claim 64 of the present application, is non-obvious in view of the references of record.

Yet further, contrary to the inference apparently asserted by the Office Action that the InterShipper reference included multiple delivery services offered by multiple carriers in its results, it is respectfully asserted that the InterShipper reference never states that the InterShipper service would include multiple delivery services offered by the "major shippers." To the contrary, the InterShipper reference specifically states that "Internet users can now get shipping rates from all major shippers ...", not by multiple delivery services offered by multiple major shippers.

Accordingly, it is respectfully asserted that the combination of the above-recited limitations of, for example, amended independent Claim 64, is therefore not disclosed, anticipated, taught or suggested by the InterShipper reference.

Moreover, because the Office Action relied on the InterShipper reference to provide the conceded missing link of a simultaneous display absent from the Kara reference, it is therefore respectfully asserted that the combination of the above-recited limitations of, for example, amended independent Claim 64, is therefore not disclosed, anticipated, taught or suggested by, and is non-obvious in view of, the combination of the Kara and InterShipper references.

For the above-given reasons and above-cited authorities, it is respectfully asserted that the complete absence of the combination of limitations recited by amended independent Claim 64 from the combination of references asserted by the Office Action, is strong evidence that the combination of limitations recited by amended independent Claim 64 is therefore not obvious.

For reasons similar to those given above with respect to amended independent Claim 64, it is respectfully asserted that the combinations of limitations recited by, for example, the Claims that are dependent on Claim 64, namely Claims 65-73, are therefore also not disclosed, anticipated, taught or suggested by the combination of the Kara and InterShipper references.

**B. Generating a Simultaneous Display of Delivery Days for Multiple Delivery Services by Multiple Carriers is Non-Obviousness**

It is respectfully asserted that the combination of limitations recited by, for example, amended independent Claim 74, are not obvious in view of the references of



record. In particular, the following combination of limitations recited in amended independent Claim 74 is respectfully asserted as non-obvious in view of the references of record:

simultaneously displaying to a user:

(A) a first delivery schedule indicia indicating that said first carrier would deliver said package to said destination on said first day if said first carrier were to deliver said package to said destination via said first delivery service;

(B) a second delivery schedule indicia indicating that said first carrier would deliver said package to said destination on said second day if said first carrier were to deliver said package to said destination via said second delivery service;

(C) a third delivery schedule indicia indicating that said second carrier would deliver said package to said destination on said third day if said second carrier were to deliver said package to said destination via said third delivery service; and

(D) a fourth delivery schedule indicia indicating that said second carrier would deliver said package to said destination on said fourth day if said second carrier were to deliver said package to said destination via said fourth delivery service.

In rejecting Claims 68-79, the Office Action again concedes that "Kara ... fails to disclose the simultaneous display of rates for each carrier that includes rates of different services ..." (*Office Action*, Topic No. 9, p. 4) but again apparently asserts by inference that *InterShipper* does. See *Office Action*, Topic No. 9, p. 4 ("InterShipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers ....").

However, for reasons similar to those described above with regard to the rejections of, for example, Claim 64, it is respectfully asserted that it would be improper to rely on the cited *InterShipper* reference as evidence of anything except "... for what is in fact disclosed in it." *Reading and Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 652 (Fed. Cir. 1984). Accordingly, because it does not disclose that its results would be displayed simultaneously, it is respectfully asserted that amended independent Claim 74 is patentable over the *InterShipper* reference, even when that reference is combined with the other references of record.

Yet further, as compared to the above-recited limitations of, for example, amended independent Claim 74, regarding identifying a delivery day for each of multiple delivery services by multiple carriers, it is respectfully submitted that the InterShipper reference only states that “[t]he free service will ... color code the results by *approximate transit time*.” InterShipper, p. 1, ¶2.

For the reasons previously given above, it is respectfully asserted that the cited InterShipper reference may only be used as a prior art reference under Section 103 “... for what is in fact disclosed in it.” Reading and Bates, 748 F.2d at 652. Therefore, because the InterShipper reference only states that “[t]he free service will ... color code the results by *approximate transit time* ...” (InterShipper, p. 1, ¶2), it is respectfully asserted that the InterShipper reference does not disclose, anticipate, teach or suggest the above-recited limitations of, for example, Claim 74, regarding identifying, and simultaneously displaying, a respective delivery day for multiple delivery services by multiple carriers. It is therefore respectfully asserted that above-recited limitations of Claim 74 are, when considered together with the other limitations recited by Claim 74, patentably distinct from, and non-obvious in view of, the disclosures of the InterShipper reference even when that reference is combined with the other references of record.

Further, for reasons similar to those given above regarding amended independent Claim 74, it is therefore respectfully asserted that the combination of the Kara and InterShipper references does not disclose, anticipate, teach or suggest the combinations of limitations recited by the Claims that are dependent on Claim 74, namely dependent Claims 75-79.

In rejecting Claims 68-79, the Office Action further asserts the UPS and FedEx references as well as the Barnett reference as grounds for its conclusion of obviousness. Office Action, Topic No. 7, p. 3; Office Action, Topic No. 10, pgs 4-5.

However, for the following reasons and authorities, it is respectfully asserted that the amended Claims of the present application are non-obvious in view of the asserted combination of the UPS, FedEx and Barnett references with the Kara and InterShipper references.

It is respectfully asserted that there is no disclosure in any of the references of record, including the FedEx, UPS and Barnett references, of an identification of “... a

[particular] day on which a [particular] carrier would deliver a particular package to a particular destination according to a particular shipping date, if [the particular] carrier were to deliver said package to said destination via a [particular] delivery service ..." as claimed by amended independent Claim 74.

In particular, the FedEx reference amounts to nothing more than a general description of various services offered by FedEx® and rules that FedEx® applies to shipments. Specifically, FedEx lists a number of FedEx® delivery services along with a brief description of each FedEx® delivery service.

For example, FedEx describes "FedEx Priority Overnight®" as providing "...delivery by 10:30 a.m. the next business day to thousands of U.S. cities in our primary service area (noon to most of the rest). Shipments may weigh up to 150 lbs., and measure up to 119" length and up to 165" in length and girth combined ... Pickup and delivery Monday-Saturday". FedEx, p. 1.

As a further example, FedEx describes "FedEx Standard Overnight®" as providing "...delivery by 3:00 p.m. the next business day to thousands of U.S. cities in our primary service area (4:30 p.m. to most of the rest, Saturday delivery not available with this service). Shipment may weigh up to 150 lbs., and measure up to 119" in length and up to 165" in length and girth combined." FedEx, p. 1.

As yet another example, FedEx describes "FedEx 2Day(SM)" as providing "delivery by 4:30 p.m. the second business day (7:30 p.m. to residential destinations) within the continental U.S. Shipments may weight up to 150 lbs., and measure up to 119" in length and up to 165" in length and girth combined." FedEx, p. 1.

As with the InterShipper reference, it is respectfully asserted that the FedEx reference is a non-enabling reference with respect to the claimed subject matter of the Claims of the present application, and can therefore not properly be used to support more than it actually discloses. See Reading and Bates, 748 F.2d at 652. Therefore, for the above-given reasons, it is respectfully asserted that the combination of limitations claimed by, for example, amended Claim 74, are non-obvious in view of the FedEx reference, even when that reference is combined with the other references of record.



Similar to the FedEx reference, the text of the UPS reference provides a description of each of its services, but fails to disclose "... an identification of "... a [particular] day on which a [particular] carrier would deliver a particular package to a particular destination according to a particular shipping date ..." as claimed by Claim 74.

The UPS reference provides a link, "Quick Cost Calculator", with each service description. According to the UPS reference, the "Quick Cost Calculator" link appears to provide a user with the ability to click the link to obtain a calculation of shipping rates, and availability and delivery times, for the particular service with which the link appears. However, it is respectfully asserted that the UPS reference's description of the "Quick Cost Calculator" link still fails to disclose "... an identification of "... a [particular] day on which a [particular] carrier would deliver a particular package to a particular destination according to a particular shipping date ..." as claimed by Claim 74.

As with the InterShipper and FedEx references, it is respectfully asserted that the UPS reference is a non-enabling reference with respect to the claimed subject matter of the Claims of the present application, and can therefore not properly be used to support more than it actually discloses. See Reading and Bates, 748 F.2d at 652. Therefore, for the above-given reasons, it is respectfully asserted that the combination of limitations claimed by, for example, amended Claim 74, are non-obvious in view of the UPS reference, even when that reference is combined with the other references of record.

The Office Action then asserts that although "Kara, Theil [sic], UPS® and FedEx® fail to disclose the use of a simultaneous display with [sic] shows the date and time of services[,] Barnett[t] discloses the use of a calendar which can be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9)." Office Action, Topic No. 10, p. 5. The Office Action then further asserts that "[i]t would have been obvious ... to have the display of rates of Kara, InterShipper, UPS® and FedEx® with respect to day and time, include the day and time, as disclosed by Barnett, in order to provide a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2)." Office Action, Topic No. 10, p. 5.

Applicants respectfully disagree that the above-quoted assertion of obviousness is properly supported by sufficient evidence as required for an obviousness rejection under MPEP §706.02(j) and MPEP §2143. In particular, it is respectfully asserted that there is no disclosure in Barnett, and for the reasons previously given above in any of the other cited references, of any "... an identification of ... a [particular] day on which a [particular] carrier would deliver a particular package to a particular destination according to a particular shipping date ..." as claimed by Claim 74.

It is respectfully asserted that the combination of limitations of, for example, Claim 74, are predictive, and determinative in nature – that is, the limitations recite an identification of a date for an event (a delivery) according to a particular reference date (a shipping date). As compared to being predictive or determinative, Barnett does not identify or determine a date on which a particular event will occur with respect to a particular reference date, but instead merely reports dates and times on which events with pre-determined schedules are so scheduled to occur.

Yet further, as compared to the limitations of, for example, Claim 68, which by virtue of its dependency on Claim 64, claims limitations for simultaneously displaying shipping rates for each of multiple delivery services offered by each of multiple carriers, Barnett does not disclose any simultaneous display of rates (see e.g., Barnett, FIG. 9). In fact, it is respectfully submitted that Barnett does not disclose any display of rates by the Barnett system. Moreover, for the reasons previously given above, it is respectfully asserted that none of the references of record disclose a simultaneous display of rates for multiple delivery services offered by multiple carriers.

For the reasons given above, it is respectfully asserted that the complete absence of the combination of limitations recited by amended independent Claim 74 from the combination of references asserted by the Office Action, is strong evidence that the combination of limitations recited by amended independent Claim 74 is therefore not obvious.

As compared to the references of record, it is respectfully asserted that one advantage of a shipping management computer system according to various embodiments of the system claimed in new Claim 74 is that such embodiments allow for a simultaneous cross-comparison of the various schedules according to which a

package would be delivered via multiple delivery services provided by each of a plurality of carriers. For example, such a system could be configured for simultaneously displaying: (1) the date on which UPS would deliver a package via an "overnight" delivery service; (2) the date on which UPS would deliver the package via a "second day" delivery service; (3) the date on which Federal Express would deliver the package via an "overnight" delivery service; and (4) the date on which Federal Express would deliver the package via a "second day" delivery service. It is respectfully asserted that such a display may be useful in allowing users to quickly compare the days on which a package would actually be delivered if the user were to ship the package on a particular shipping date via one of various delivery services. This can be especially useful if different carriers have different policies regarding, for example, whether a package sent via overnight delivery on a Friday would be delivered on the next weekday (Saturday) or on the next business day (Monday).

For the above-given reason and authorities, it is respectfully asserted that the above-cited limitations of independent Claim 74, and therefore of the Claims dependent on Claim 74, namely Claims 75-79, are not disclosed, anticipated, taught or suggested by any of the references of record, whether considered alone or in combination with any other reference of record.

#### **CONCLUSION**

For the foregoing reasons and authorities, it is respectfully asserted that the invention disclosed and claimed by Claims 64-79 of the present application are not fairly taught by any of the references of record taken either alone or in combination, are distinguished from, are not obvious in view of, and are therefore patentable over, the references of record. Accordingly, it is respectfully asserted that the application is

condition for allowance. Accordingly, reconsideration and allowance of Claims 64-79 are respectfully requested.

Respectfully submitted,  
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